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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,377	09/17/2003	Joe Don Byles		4570

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JOE D. BYLES  
20 TIMBER MEADOW  
NEW BRAUNFELS, TX 78132

EXAMINER
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NGUYEN, SON T

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/664,377

**Applicant(s)**

BYLES, JOE DON

**Examiner**

Son T. Nguyen

**Art Unit**

3643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-15 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

*Ant 123*  
*Prim Exm 3643*

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 17 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 2,3,8,12,13,14,15** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Nowhere in the specification supports or explains the drain holes at a level where conventional potting soil interfaces with the upper surface; the open channel from the bottom of the soil layer to the bottom of the pot; a water supply conduit; and a flow controlled emission device. The only hole that was disclosed is ref. 15, which is not the same as drainage holes.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 1-15** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There are numerous unclear language in the claims. For example, claim 1, line 4, "the material" lacks prior antecedent basis. Claim 2, line 2, the phrase "adding drain holes to the closed sealed planter pot" is misleading because it appears that the drain holes are added to the pot and not the interface between the

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soil and the porous structure. It would be better that applicant leave out "to the closed sealed planter pot". In addition, drain holes are not disclosed in the specification; therefore, claiming drain holes are unclear. Note, these are only some examples. Applicant is encourage to review all claims and amend the claims to resolve unclear language.

### ***Drawings***

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the drain holes, open channel, water supply conduit, and flow controlled emission device must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1-5,9,10,12,13** are rejected under 35 U.S.C. 102(b) as being anticipated by US 4791755 (herein US755).

For claim 1, US755 discloses a method of maintaining an air and water reservoir within a closed, sealed planter pot 2, the method comprising the steps of: positioning a

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porous and permeable water and air holding structure 6 capable of holding air within the material in a completely submerged water condition within a closed and sealed portion of the planter pot (walls 11,10,16 of the pot) such that roots 7,8 of a plant located above the material can grow into the porous and permeable water and air holding structure and access air and water.

For claim 2, US755 discloses the step of: adding drain holes (drain holes occurred inherently between particles of the soil 5 and the granular structure 6 since these materials are porous, see col. 2, lines 36-53, col. 3, lines 25-27) to the closed sealed planter pot at a level where conventional potting soil of a planted plant interfaces with the upper surface of the porous and permeable water and air holding structure, so as to allow the conventional potting soil to be in a constantly drained state and the porous and permeable water and air holding structure to be in a state sealed from drainage.

For claim 3, US755 discloses the step of: creating drain holes (drain holes occurred naturally between particles of the soil 5 and the granular structure 6, see col. 2, lines 36-53, col. 3, lines 25-27) at a level where conventional potting soil of a planted plant interfaces with the upper surface of the porous and permeable water and air holding structure by providing air and water tight passages which extend from the bottom of the porous and permeable water and air holding structure to the soil interface, providing a open channel (open channel inherently exists between grains of soil and the structure 6 due to the grains of soil and structure not being tightly closed together) from

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the bottom of the soil layer to the bottom of the pot while maintaining the permeable water and air holding structure in a sealed state from drainage.

For claim 4, US755 discloses a method of planting a plant within a planter pot 2, the method comprising the steps of: placing a plant directly onto a porous and permeable water and air holding structure 6 which is located within a sealed pot (sealed by the walls 11,10,16).

For claim 5, US755 discloses a method of planting a plant with a planter pot 2, the method comprising the steps of: placing a plant into a receiving pocket (created first before root ball 5 is inserted so as to allow the root ball to be inserted into the structure 6) within a porous and permeable water and air holding structure 6 with a sealed pot (sealed by the walls 11,10,16).

For claim 9, US755 discloses a planter pot water and air holding apparatus incorporated into a sealed, water tight planter pot 2 (sealed by the walls 11,10,16), the apparatus comprising: a sealed water tight planter pot 2; and a porous and permeable water and air holding structure 6 capable of holding air within the material in a completely submerged water condition within a closed and sealed portion of the planter pot.

For claim 10, US755 discloses the porous and permeable water and air holding structure capable of holding air within the material in a completely submerged is selected from a group consisting of an open cell foam material, non-reticulated or reticulated, a reticulated material, and a granular material (col. 2, lines 36-42, col. 3, lines 25-30, col. 6, lines 5-15).

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For claim 12, US755 discloses adding drain holes (drain holes occurred inherently between particles of the soil 5 and the granular structure 6 since these materials are porous, see col. 2, lines 36-53, col. 3, lines 25-27) to the closed sealed planter pot at a level where conventional potting soil of a planted plant interfaces with the upper surface of the porous and permeable water and air holding structure, so as to allow the conventional potting soil to be in a constantly drained state and the porous and permeable water and air holding structure to be in a state sealed from drainage.

For claim 13, US755 discloses at least one drain hole (drain holes occurred naturally between particles of the soil 5 and the granular structure 6, see col. 2, lines 36-53, col. 3, lines 25-27) at a level where conventional potting soil of a planted plant interfaces with the upper surface of the porous and permeable water and air holding structure by providing air and water tight passages which extend from the bottom of the porous and permeable water and air holding structure to the soil interface, providing a open channel (open channel inherently exists between grains of soil and the structure 6 due to the grains of soil and structure not being tightly closed together) from the bottom of the soil layer to the bottom of the pot while maintaining the permeable water and air holding structure in a sealed state from drainage.

8. **Claims 4-7** are rejected under 35 U.S.C. 102(b) as being anticipated by US 4903432 (herein US432).

For claim 4, US432 discloses a method of planting a plant 40 within a planter pot 25, the method comprising the steps of: placing a plant 40 directly onto a porous and permeable water and air holding structure 35 which is located within a sealed pot.

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For claim 5, US432 discloses a method of planting a plant 40 with a planter pot 25, the method comprising the steps of: placing a plant 40 into a receiving pocket (created when inserting seeds 40 into the structure 35) within a porous and permeable water and air holding structure 35 with a sealed pot.

For claims 6 & 7, US432 discloses the step of: placing a decorative cover material 36 on top of the porous and permeable water and air holding structure.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 8,14,15** are rejected under 35 U.S.C. 103(a) as being unpatentable over US755 (as above) in view of US 5133151 (herein US151).

For claim 8, US755 is silent about adding a water supply conduit. US151 teaches a method of planting a plant in a porous and permeable water and air holding structure 23, the method comprising the step of: adding a water supply conduit 7,9,11 to charge into the sealed a porous and permeable water and air holding structure 23 at a controlled rate (by valve 16 and computer 12) to provide water to the roots of the plant growing into the porous and permeable water and air holding structure. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the step of adding a water supply conduit as taught by US151 in the method of US755 in order to allow for automatic controlled watering of the plant.



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For claim 14, US755 is silent about adding a water supply conduit. US151 teaches a planter pot water and air holding apparatus comprising a water supply conduit 7,9,11 to charge into the sealed a porous and permeable water and air holding structure 23 at a controlled rate (by valve 16 and computer 12) to provide water to the roots of the plant growing into the porous and permeable water and air holding structure. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a water supply conduit as taught by US151 in the apparatus of US755 in order to allow for automatic controlled watering of the plant.

For claim 15, in addition to the above, US151 further discloses a flow controlled emission device 9,10 (the flow is controlled by openings 10) inserted into the sealed porous and permeable water and air holding structure attached to the water supply conduit. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a flow controlled emission device as taught by US151 in the apparatus of US755 as modified by US151 in order to control water flow by seeping it slowly through openings 10 (of US151).

11. **Claim 11** is rejected under 35 U.S.C. 103(a) as being unpatentable over US755 (as above). US755 teaches a foam material but not specifically a polyether polyurethane open cell, non-reticulated material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the porous and permeable water and air holding structure of US755 out of polyether polyurethane open cell, non-reticulated material, since it has been held to be within the

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general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious choice.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Nguyen whose telephone number is (703) 305-0765. The examiner can normally be reached on Monday - Friday from 9:00 a.m. to 5:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon, can be reached at (703) 308-2574. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service at (703) 872-9325. The official fax number is 703-872-9306.



Son T. Nguyen  
Primary Examiner, GAU 3643  
February 9, 2004